



ARE Patent Law Alert: *Williamson v. Citrix Online*

Author(s): Neil M. Zipkin,

(June 18, 2015) On June 16, 2015, the Federal Circuit Court of Appeals issued a substitute decision in *Williamson v. Citrix Online LLC*, 2013-1130, slip op. (June 16, 2015), in which the *en banc* Federal Circuit overruled prior precedent concerning means-plus-function claims. In particular, the court lowered the standard required to show, even in absence of the word “means,” that a patent claim is governed by the means-plus-function provisions of 35 U.S.C. 112(f).

Proceedings Below

Richard A. Williamson, as the trustee for the At Home Corporation Bondholders’ Liquidating Trust, owns U.S. Pat. No. 6,155,840, “System and method for distributed learning” (“the ‘840 Patent”), which the Federal Circuit characterizes as describing “a virtual classroom environment.” In March 2011, Williamson sued many of the major makers of online collaboration systems, including Citrix, Microsoft, Cisco, Adobe, and IBM, alleging infringement of the ‘840 Patent. After claim construction, the Central District of California invalidated several claims of the ‘840 Patent as indefinite.¹

The District Court concluded that even though those claims do not use the phrase “means for,” they were governed by the “means-plus-function” rules that were then codified as 35 U.S.C. § 112 ¶ 6.² Under the rules of ¶ 6, because the claims were means-plus-function claims but lacked a description of any corresponding structure, they were determined to be indefinite and invalid.

The Prior Federal Circuit Decision

Williamson appealed, and in 2014, the Federal Circuit issued an opinion, 770 F.3d 1371 (Fed. Cir. 2014), reversing the District Court. The Circuit explained that because the ‘840 Patent did not use the term “means for,” the presumption that the claim was not a means-plus-function claim was very strong, and overcoming it required a showing that “skilled artisans, after reading the patent, would conclude that [the] claim limitation is so devoid of structure that the drafter constructively engaged in means-plus-function claiming.” *Id*



. (emphasis added). This standard was first expressed in *Lighting World v. Birchwood Lighting*, 382 F.3d 1354 (Fed. Cir. 2004).

The appellants sought *en banc* review, arguing that the Federal Circuit's standard for overcoming the presumption was too high. The Federal Circuit granted review, sitting *en banc* as to that point, and withdrew its 2014 opinion, substituting its 2015 opinion.

The New Old Rule

The Federal Circuit explicitly overruled the *Lighting World* rule and the cases that followed it, concluding that the heightened standard for overcoming the presumption "has the inappropriate practical effect of placing a thumb on what should otherwise be a balanced analytical scale. It has shifted the balance struck by Congress in passing § 112, para. 6 and has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute." *Williamson*, slip op. at 15.

The Federal Circuit instead held that the correct standard is the standard that predates *Lighting World*: "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure. When a claim term lacks the word 'means,' the presumption can be overcome and § 112, para. 6 will apply if the challenger demonstrates that the claim term fails to 'recite sufficiently definite structure' or else recites 'function without reciting sufficient structure for performing that function.'" *Id.* at 16.

The practical effect of this rule for claim drafters is that merely omitting the word "means" may not be enough to escape means-plus-function rules. This is significant for claim drafting because a claim governed by § 112(f) can only be infringed by the same structures as those described in the specification or their equivalents.

This change will especially impact patents on software, which some commentators had suggested took advantage of the strong presumption to achieve overly-broad claims that were not properly limited by means-plus-function rules.

For more information on how this recent development may affect your organization, please contact one of our attorneys.

[Neil Zipkin](#) is a partner and [William Frank](#) is an associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues including litigating patent, trademark and other intellectual



property disputes. The authors may be reached at nzipkin@arelaw.com
and wfrank@arelaw.com.

¹ The District Court also found non-infringement of a number of other claims of the '840 Patent, and the Federal Circuit has vacated that judgment, but that is outside the scope of this alert.

² That paragraph was later renumbered by the America Invents Act to be 35 U.S.C. § 112(f), but the text itself is identical.